

Remarks:

1. Objections and Rejections.

Applicant further acknowledges with appreciation that the Examiner has allowed claims 18 and 20 and indicates that claims 7, 8, and 12 contain allowable subject matter and would be allowable if rewritten in independent form to include the limitations of their base claim and any intervening claims. In addition, although the Office Action rejects claim 17 under 35 U.S.C. § 112, ¶2, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, the Examiner indicates that if claim 17 were amended to correct a lack of antecedent basis for one of its elements, claim 17 also would contain allowable subject matter and would be allowable if rewritten to overcome the indefiniteness rejections and in independent form to include the limitations of its base claim and any intervening claims.

Nevertheless, claims 1-6, 10, 11, 13-16, 21-24, and 26-28 stand rejected, under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 5,522,512 to Archer et al. (“Archer”). Moreover, claims 9 and 25 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Archer in view of Patent No. US 6,351,676 B1 to Thomas; claims 15, 19, 22, and 30 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Archer in view of U.S. Patent No. 4,191, 294 to McGrath, Jr. et al. (“McGrath, Jr.”); and claim 29 stands rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by U.S. Patent No. 4,784,275 to Fridge in view of Archer. Applicant respectfully traverses.

2. Indefiniteness Rejections.

As noted above, the Office Action rejects claim 17 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action rejects claim 17, as allegedly failing to provide proper antecedent basis for the claim element: “said control unit.” The Office Action states, however, that if this element was rewritten as “a control unit,” claim 17 also would contain allowable subject matter and would be allowable if rewritten in independent form to include the limitations of its base claim and any intervening claims. Therefore, Applicant has amended claim 1 to include the limitations of claim 17 and to describe “a control unit,” according to the Examiner’s suggestion, and respectfully requests that the Examiner withdraw this rejection.

3. Anticipation Rejection

As noted above, claims 1-6, 10, 11, 13-16, 21-24, and 26-28 stand rejected as allegedly anticipated by Archer. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. . . . ‘The identical invention must be shown in as complete detail as is contained in the . . . claim.’” MPEP 2131 (citations omitted). In view of the following amendments and remarks, Applicant respectfully traverses.

a. Claims 1, 3, and 5.

With respect to independent claims 1 and 21, the Office Action contends that Archer discloses each of the described elements of each claim. In particular, with respect to claim 1, the Office Action contends that Archer’s **Figs. 1, 7, and 8** discloses a system for dispensing items 1, e.g., tablets, comprising a hopper 11 comprising a plurality of dispensing paths, e.g., vibratory feeder 103 and conveyor belts 105, for dispensing said items; a sensing unit, e.g., inspection system 3 or tablet sensing module 107, for measuring a physical characteristic of each of said dispensed items; a plurality of container chutes, e.g., container streams 45 or 47, for directing each of said dispensed items, the measured physical characteristic of which is within a predetermined range of physical characteristics, to containers; and a plurality of diversion chutes, e.g., reject stream 39, for diverting each of said dispensed items, the measured physical characteristic of which is greater than or less than said predetermined range of physical characteristics, away from said containers. In view of the foregoing amendment to claim 1, Applicant maintains that the anticipation rejection of claim 1 now is moot. Nevertheless, Applicant maintains that Archer fails to disclose a holding chamber in the dispensing head, as described in Applicant’s claim 3, and that the Examiner incorrectly equates mechanical flap 67 with the claimed bifurcation device of claim 5.

Applicant’s claim 3 describes a dispensing head comprising at least one holding chamber, wherein the at least one holding chamber directs each of the dispensed items, the measured physical characteristic of which is within the predetermined range of physical characteristics, to one of the container chutes and diverts each of the dispensed items, the measured physical characteristic of which is greater than or less than the predetermined range of physical characteristics, to one of the diversion chutes. Referring to Archer’s **Fig. 8**, however, mechanical flaps 63, 65, and 67, work together, so that tablets are diverted to the correct chute.

Archer explains that diverter body 57 receives the tablets “in free fall” from the end of the conveyor and that the tablets are diverted only once to recycle stream (chute) 37, reject stream (chute) 39, or container stream (chute) 45 or 47. Archer, Column 8, Lines 19-54. Because Archer’s tablets enter diverter body 57 in free fall and do not touch the side walls until they have been diverted, we maintain diverter body 57 does not comprise a “holding chamber.” Moreover, in view of the configuration of diverter body 57 depicted in **Fig. 8**, diverter body 57 is not configured to “hold” tablets within diverter body 57. Therefore, Archer does not disclose each and every limitation of Applicant’s invention, as described in claim 3.

Similarly, Applicant’s claim 5 describes a dispensing head further comprising a first chamber; a second chamber; and a bifurcation device for directing items to one of the first chamber and the second chamber. As noted above, claim 1 describes a plurality of container chutes and a plurality of diversion chutes, and the Examiner already has identified container streams 45 and 47 as allegedly conforming to the container chutes. Therefore, Applicant maintains that Archer does not disclose a first and second chamber to which items are directed by the bifurcation device. Appl’n, Para. [0050]; **Figs. 7a-7h**. Therefore, Archer does not disclose each and every limitation of Applicant’s invention, as described in claim 5.

In view of the foregoing remarks, Applicant respectfully requests that the Examiner withdraw the anticipation rejections of claims 1, 3 and 5. Consequently, by drafting amended claims to include the limitations of claims 3, 5, 7, 8, 12, and 17, Applicant renders all of the pending, apparatus claims allowable. Thus, in view of these amendments and remarks, Applicant respectfully requests that the Examiner withdraw the anticipation rejections of claims 1-6, 10, 11, and 13-16.

b. Claim 21.

Similarly, Applicant is amending method claim 21 to describe steps corresponding to the limitations of claim 3 or 5 and thereby distinguishing claim 21 and the claims dependent therefrom over Archer. More specifically, Applicant is amending claim 21 to provide for the step of “delivering said items to and holding said items within at least one holding chamber” and “directing each of said items . . . from said at least one holding chamber to a container chute” and “directing each of said items . . . from said at least one holding chamber to a diversion chute.” In view of these amendments and the foregoing remarks, Applicant

respectfully requests that the Examiner withdraw the anticipation rejections of claim 21, as well as of claims amended 22-24, and 26-28.

4. Obviousness Rejections

As noted above, the Office Action rejects claims 9 and 25, as allegedly rendered obvious by Archer in view of Thomas; claims 15, 19, 22, and 30 as allegedly rendered obvious by Archer in view of McGrath, Jr.; and claim 29 as allegedly rendered obvious by Fridge in view of Archer. In order for the Office Action to establish a prima facie case of obviousness, at least three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as proposed by the Office Action. Second, there must be a reasonable expectation of success. Third, the prior art references must disclose or suggest all the claim limitations. MPEP 2143. For the reasons set forth below, Applicant maintains that the Office Action fails to establish a prima facie case of obviousness with respect to at least some of the rejected claims.

a. Claims 15, 19, 22, and 30.

As noted above, claims 15, 19, 22, and 30 stand rejected as allegedly rendered obvious by Archer in view of McGrath, Jr. Applicant is canceling independent claims 19 and 30 (as well as claim 29), without prejudice, in order to reduce the excess claim fees due as a result of the addition of the new independent claims described above.

With respect to the limitations of claims 15 and 22, however, the Office Action does not contend that the elements or steps added by these claims are disclosed or suggested by Archer or McGrath, Jr. Instead, the Examiner states that “to provide that Archer et al’s system utilizes a conveyor for the rejected articles, would be obvious as such conveyors are frequently used in material handling, and therefore, this conventional handling experience is not afforded any patentable weight.” Office Action, Page 4, Lines 3-6. Nevertheless, by this statement, the Office Action merely contends that the use of a conveyor to receive diverted items was within the capabilities of a person skilled in the art at the time of the application because conveyors were known in other aspects of materials handling. The MPEP, however, makes clear that is not the test for obviousness. MPEP 2143.01, pg. 2100-131 (Rev. 2, 8th ed. May 2004).

Although the Office Action alleges that the use of such conveyors is conventional, the Office Action does not assert that any of the references cited in the Office Action or by

Applicant discloses or suggest the claimed use of such compressors to receive diverted items. Further, even where Archer describes the use of conveyors, e.g., conveyor belt 105 and bottle out-feed and in-feed conveyors 115 and 113, the Office Action fails to show that Archer discloses or suggests the use of a conveyor to receive diverted items. Archer, Column 18, Lines 7-17. Moreover, it is not merely the presence of a conveyor that the cited references must show, these references also must show that conveyor's relationship with the diversion chutes. Because the Office Action fails to demonstrate that Archer in view of McGrath, Jr. discloses or suggested each and every element of the invention of claims 15 and 22 or that there is a suggestion or motivation to modify Archer in view of McGrath, Jr. or some other reference to include a conveyor "positioned in communication with said plurality of diversion chutes." For these reasons, Applicant maintains that the Office Action has failed to establish a prima facie case of obviousness with respect of claims 15 or 22.

Nevertheless, in order clearly to overcome the obviousness rejections by Archer in view of McGrath, Jr., Applicant is rewriting claim 15 in independent form to include the limitations of claim 1; and rewriting claim 22 in independent form to include the limitations of claim 21.¹ In view of these amendments and the foregoing remarks, Applicant respectfully requests that the Examiner withdraw the obviousness rejections of amended claims 15, 16, and 22.

b. Claims 9 and 25.

Claims 9 and 25 depend from claim amended claim 1 and amended claim 21, respectively. "If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03 (citations omitted). Therefore, Applicant's amendments and remarks with respect to claims 1 and 21, the obviousness rejections to claims 9 and 25 are untenable. Moreover, the Office Action does not suggest that Thomas discloses or suggests the elements of claims 1 and 21 that are missing from Archer. Therefore, Applicant respectfully requests that the Examiner withdraw the rejections of claims 9 and 25.

¹ This rewritten claim is new claim 31.

Conclusion:

Applicant respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicant's representatives, either in person or by telephone, would expedite prosecution of this application, we would welcome such an opportunity.

Respectfully submitted,

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Enclosures